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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,037	01/28/2004	Charles W. Finkl	FINKL162CIPD2	4800

7590 03/25/2005

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EXAMINER

KASTLER, SCOTT R

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/767,037

Applicant(s)

FINKL ET AL.

Examiner

Scott Kastler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-10 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-5 and 7-10 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

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***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/15/2005 has been entered.

***Claim Objections***

Claims 5 and 8 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The above claims do not fairly further limit independent claim 1 because the above claims recite only limitations dealing with the manner or method in which the claimed apparatus is to be employed (the manner in which the claimed apparatus is to be disposed with respect to a workpiece to be heated). It has been well settled that the manner or method of use of an apparatus cannot alone, be relied upon to fairly further limit claims to the apparatus itself. See MPEP 2114.

Claim 3 is objected to because of the following informalities: the above claim is informal because the term "the means for confining" lacks proper antecedent basis (the "confining means" term was removed from claim 1, from which this claim depends, in the amendment filed on 3/15/2005).

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Basinger.

Basinger teaches an apparatus (10) for locally heating a workpiece including parallel runs of induction heating elements (20) in a common plane, where the heating elements (20) are surrounded by “structural heat blocking members (shield members 22) at all locations except where the heating elements are employed to heat a workpiece, thereby showing all aspects of the above claims, since the manner or method of use of the claimed apparatus cannot be relied upon to fairly further limit claims to the apparatus itself. See MPEP 2114.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Butler et al. Butler et al teaches an apparatus for heating a workpiece including a plurality of parallel electric heating elements (52) surrounded by ceramic “structural heat blocking members” (22) for locally heating a workpiece, thereby showing all aspects of the above claims since the use of the apparatus for specifically treating a die block is a method of use limitation which cannot be relied upon to fairly further limit claims to the apparatus itself. See MPEP 2114.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa in view of Butler et al. Nishikawa teaches that it was known in the art at the time the invention was made to employ electric heating from infrared heaters and associated control means in the form of halogen lamps (including short wave tungsten halogen lamps) to selectively harden portions of a workpiece while employing means for confining the heat from the lamps to the portion to be heated ( the water cooled jigs for example, see col. 4, line 50 to col. 7 line 5 for example) thereby showing all properly limiting aspects of the above claims except the arrangement of the heating elements of Nishikawa as adjacent parallel runs of heating elements, since the use of the claimed apparatus to specifically heat treat any particular type of workpiece in any particular type of heat treating process (such as the heating of a steel die without the use of graphite coating the die) cannot be relied upon to fairly further limit claims to the apparatus itself when, as in the instant case, the applied prior art apparatus could be employed if desired to perform the claimed function. As applied to claim 1 above, Butler et al teaches that it was made to deploy a plurality of heating elements within a shielding “structural heat blocking members” in a parallel arrangement, where the heating elements may comprise high energy lamps of the type disclosed by Nishikawa (see col. 5 line 39 for example). Because Butler et al specifically states that heater lamps of the type disclosed by Nishikawa are appropriate for use in the

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apparatus disclosed by Butler et al, motivation to employ the heater system of Nishikawa, in the apparatus disclosed by Butler et al, would have been a modification obvious to one of ordinary skill in the art at the time the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Basinger in view of Butler et al. As applied to claim 1 above, Basinger shows all aspects of the above claims except the use of any specific materials for the shield means (22) (structural heat blocking members). Butler et al, at col. 3 lines 40-45 for example, teaches that it was known in the art at the time the invention was made to employ ceramic materials as shield materials for the purpose of confining heat from heating members where the shield materials surround the heating members. Because the shield (22) of Basinger must be made of some unspecified material, and Butler et al teaches that ceramics are a desired material for the purpose of forming shield members of the type employed by Basinger, motivation to employ ceramic materials, as taught by Butler et al, for forming the shield members (22) of Basinger, would have been a modification obvious to one of ordinary skill in the art at the time the invention was made.

### ***Response to Arguments***

Applicant's arguments, see pages 11-13, filed on 3/15/2005, with respect to the rejection(s) of newly amended claim(s) 1-5 and 7-10 under 35 USC 102(b) have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the references cited above.

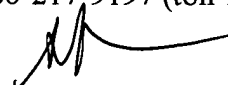
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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Kastler whose telephone number is (571) 272-1243. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Scott Kastler  
Primary Examiner  
Art Unit 1742

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